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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,432	06/04/2001	Kelli H. Kennedy	10007276-1	5664

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EXAMINER

MANIWANG, JOSEPH R

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/874,432

Applicant(s)

KENNEDY ET AL.

Examiner

Joseph R Maniwang

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: various references to Fig. 4, reference element 410 that don't exist in drawings (see Specification, p. 11, line 16). Appropriate correction is required.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Fig. 4, reference element 410 (see Specification, p. 11, line 16). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C.-112:

Art Unit: 2144

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 17 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 17 and 33 recite "wherein the source device includes a computer operatively configured with a Windows® operating system". The trademark or trade name is used in the claims as a limitation to identify or describe a particular material or product, and thus the claims do not comply with the requirements of the 35 U.S.C. 112, second paragraph. *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-6, 9, 16-22, 25, 32-38, 41, 46-49, 57, and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Shaw et al. (U.S. Pat. No. 5,845,058), hereinafter referred to as Shaw.

8. Regarding claims 1, 19, 35, and 46, Shaw disclosed a method and system for printing documents. Shaw disclosed using an application program on a source device to generate content to print, such as a document, and further disclosed converting the document into an "enhanced metafile format" (see column 5, line 66 through column 6, line 45). Shaw described such an enhanced metafile format as a device-independent format (see column 2, line 66 through column 3, line 6). Thus, Shaw disclosed converting application-specific content into device-independent formatted data as claimed. The formatted data was then provided to a service device, in this case a print server where the print job was spooled and processed (see column 2, lines 23-38). Shaw disclosed the ability for the source device to provide additional information associated with the print job to the service device (see column 10, lines 1-14).

9. Regarding claims 2, 20, 36, and 47, Shaw disclosed creating a metafile having data that represents graphical content (see column 3, lines 7-15).

10. Regarding claims 3, 21, 37, and 48, Shaw disclosed graphical content to include image content (see column 3, lines 23-27).

11. Regarding claim 4, Shaw disclosed causing the service device to process the data by printing the document (see column 1, lines 37-45).

12. Regarding claim 5, Shaw disclosed causing the service device to process the data by selectively distributing the data (see column 9, lines 45-53).

Art Unit: 2144

13. Regarding claims 6, 22, 38, and 49, Shaw disclosed the use of GDI for converting data during a playback of metafile records (see column 6, lines 46-64).
14. Regarding claims 9, 25, and 41, Shaw disclosed providing the formatted data to a service device over a network as claimed (see column 6, line 65 through column 7, line 9).
15. Regarding claims 16, 32, and 57, Shaw disclosed the source device comprising a computer as claimed (see column 5, lines 54-65).
16. Regarding claims 17 and 33, Shaw disclosed the source device to include a Windows operating system as claimed (see column 5, line 60).
17. Regarding claims 18, 34, and 58, Shaw disclosed the service device operating as a server as claimed (see column 5, lines 44-53).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 7, 8, 10-15, 23, 24, 26-31, 39, 40, 42-45, 50-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al. (U.S. Pat. No. 5,845,058), hereinafter referred to as Shaw, and further in view of Adamske et al. (U.S. Pat. No. 6,615,234), hereinafter referred to as Adamske.

Art Unit: 2144

20. Shaw disclosed a method and system for printing documents. Shaw disclosed using an application program on a source device to generate content to print, and further disclosed converting the document into an "enhanced metafile format" (see column 5, line 66 through column 6, line 45), such an enhanced metafile format described as a device-independent format (see column 2, line 66 through column 3, line 6). The formatted data was provided to a service device, in this case a print server where the print job was spooled and processed (see column 2, lines 23-38). Shaw disclosed the ability for the source device to provide additional information associated with the print job to the service device (see column 10, lines 1-14). Shaw disclosed the use of GDI for converting data during a playback of metafile records (see column 6, lines 46-64). Shaw also disclosed providing the formatted data to the service device over a network (see column 6, line 65 through column 7, line 9).

21. While Shaw disclosed formatting data using GDI, Shaw did not specifically disclose converting data into PDL data such as PostScript or PDF format. Furthermore, while Shaw disclosed the use of a network for transferring data to a server, Shaw did not specifically disclose a type of network or communication protocol. Lastly, Shaw did not specifically disclose the use of a support program including a GUI, such as a browser, launched by a port monitor process to communicate over the network with the service device.

22. In a related art of electronic documents, Adamske disclosed a method and system for network-based document delivery. Similar to Shaw, the invention of Adamske included a client, electronic content, a server to which the content was sent

Art Unit: 2144

over a network, and a conversion program to reformat the content from its application-specific format to another format. However, in addition to this, Adamske further disclosed the use of the Internet as a network, and converting content to a printable PostScript format (see column 2, lines 4-12; column 4, lines 40-48; column 5, lines 33-38). Adamske also disclosed the use of HTTP for communicating through the network (see column 5, line 1). Finally, Adamske disclosed the use of a support program for communicating with the server to provide additional information related to the content (see column 6, lines 24-65). Such a support program could include a browser as claimed (see column 5, lines 15-28; column 6, lines 24-26).

23. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Shaw and Adamske to provide a system for converting content into device-independent formatted data, such as PostScript or PDF format, using a network such as a TCP/IP-based network and HTTP to upload the data to a service device, and further providing a support program such as a browser to communicate with the service device as claimed. As Shaw sought to overcome the limiting problem of device-specific data (see column 1, lines 25-33), one of ordinary skill in the art would have been motivated to consider incorporating the teachings of Adamske as they provided a way to convert data into a portable printable format, such as PostScript, independent of the application used to create the data (see column 5, lines 29-46). An ordinary artisan would have further been motivated to consider the type of network used by Adamske to allow for scalability of the system (see column 5, line 61). Finally, one of ordinary skill would have been motivated by Adamske to

Art Unit: 2144

consider the use of a support program such as a browser as it helped a user to preview the document and confirm a hard copy of the document electronically in an efficient manner (see column 6, lines 12-23).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hohensee et al. (U.S. Pat. No. 6,067,554) disclosed a method and system for displaying print documents.

deBry et al. (U.S. Pat. No. 6,538,706) disclosed a conversion program for decomposing PDF file.

Ishizuka (U.S. Pat. App. Pub. 2002/0065873) disclosed a method and system for printing from a wireless device on the Internet.

Boyce (U.S. Pat. App. Pub. 2002/0089690) disclosed a system for transmitting a file from a client to a server for printing.

Young (U.S. Pat. App. Pub. 2002/0131066) disclosed a network printing method and system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William A Cuchlinski can be reached on (571) 272-3925. The fax phone

Art Unit: 2144

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM



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